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10/573,408	10/02/2006	Robert Pickup	127542	2964
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OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850			KRISHNAN, VIVEK V	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/573,408	Applicant(s) PICKUP, ROBERT
	Examiner VIVEK KRISHNAN	Art Unit 4121

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 02 October 2006.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-20 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-20 is/are rejected.

7) Claim(s) 1-3, 5-7, and 9 is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/0256/06)
 Paper No(s)/Mail Date April 4, 2006

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____

5) Notice of Informal Patent Application

6) Other: _____

DETAILED ACTION

This is a Non-Final Office Action Correspondence in response to U.S. Application No. 10/573408 filed on October 2, 2006, claiming a U.S. National Stage entry under 35 U.S.C. 371 of International Application PCT/AU04/01321, filed on September 24, 2004, which claims priority to Australian Patent Application No. 2003905265, filed on September 26, 2003. Claims 1-20 are pending.

Examiner acknowledges receipt of the preliminary amendment filed on March 27, 2006.

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-3 and 5-7 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claims 1-3 and 5-7 recite the limitation "**hostname**". The term hostname is vague and indefinite and should be clearly defined by Applicant.

5. Claim 2 recites the limitation "**a hostname**". It is not clear whether recited hostname is different from the hostname introduced in Claim 1. The recited limitation should be corrected to clearly distinguish the terms.

6. Claim 2 recites the limitation "**a domain name server**". It is not clear whether recited domain name server is different from the domain name server introduced in Claim 1. The recited limitation should be corrected to clearly distinguish the terms.

7. Claim 3 recites the limitation "**a domain name server**". It is not clear whether recited domain name server is different from the domain name server introduced earlier within Claim 3. The recited limitation should be corrected to clearly distinguish the terms.

8. Claims 5-7 recite the limitation "**the resolved hostname**". No resolved hostname is introduced in Claims 5-7 or described in any prior claim that Claims 5-7 depend upon. There is insufficient antecedent basis for this limitation in the claim.

Claim Objections

9. Claims 3 and 9 are objected to because of the following informalities:

Claim 3 recites the limitation "**received mail server**". Recited limitation should be corrected to read "recipient mail server" or otherwise be corrected to provide sufficient support for the term.

Claim 3 recites the limitation "**this unique hostname**". Recited limitation should be corrected to read "this unique identifier" or otherwise be corrected to provide sufficient support for the term.

Claim 9 recites the limitation "**the vendor**". No vendor is introduced in Claim 9 or described in any prior claim that Claim 9 depends upon. Recited limitation should be corrected to read "the sender" or otherwise be corrected to provide sufficient support for the term.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-7, 11-16, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,986,049 to Delany.

12. Regarding Claim 1, Delany discloses a **method for delivering electronic messages from a sender to a recipient over a communications network, the method including:**

verifying authorization of an email message, wherein verifying authorization of the email message includes generating a hostname using information in the email message transmission and querying a domain name server using the generated hostname (Delany; column 6 lines 20-67 and column 7 lines 1-2, discloses verifying authorization of an email message by using the digital signature included the email message transmission to query a domain name server);

Delany does not explicitly disclose receiving an email message verification request from a recipient mail server; and transmitting a verification result to the recipient mail server, wherein the verification result is valid when the generated hostname is successfully retrieved from the domain name server.

However, Delany delegates the responsibility of verifying the authorization of the email message directly to the recipient mail server. The recipient mail server, as disclosed by Delany, performs the step of verification in response to receiving an email message instead of making a request to another server to verify the email message. Hence, the steps of receiving an email message verification request from a recipient mail server, and transmitting a verification result to the recipient mail server are integrated into the functionality of the prior art recipient mail server, as disclosed by Delany.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify a recipient mail server verifying the authorization of an email message, as disclosed by Delany, such that the functionality of verifying the authorization of an email message is delegated to a separate server and the recipient mail server determines the authorization of the email message through communication with the separate server.

One of ordinary skill in the art at the time the invention was made would have been motivated to make this modification since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlcnrnan*, 168 USPQ 177, 179.

13. Regarding Claim 2, Delany, as modified, discloses each and every limitation of Claim 1. Delany further discloses **generating a unique identifier for the message from the sender to the recipient** (Delany; column 5 lines 27-67 and column 6 lines 1-20, discloses generating a digital signature for the email message); **and** **storing a hostname on a domain name server based upon this unique identifier for email transmission authorization** (Delany; column 5 lines 27-67 and column 6 lines 1-20, discloses storing a text record including a hostname on a domain name server based on the digital signature for email transmission authorization).

Delany does not explicitly disclose **receiving a delivery request from a sender mail server, the delivery request including a recipient email address and a sender identification**.

However, Delany delegates the responsibility of generating a unique identifier for the email message and storing a hostname on a domain name server based on the unique identifier directly to the sender mail server. The sender mail server, as disclosed by Delany, performs the steps of generating a unique identifier and storing a hostname on a domain name server when transmitting the email. Hence, the step of receiving a delivery request from a sender mail server is integrated into the functionality of the prior art sender mail server, as disclosed by Delany.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify a sender mail server generating a unique identifier for the email message and storing a hostname on a domain name server based on the unique identifier, as disclosed by Delany, such that the functionality of generating a unique identifier and storing a hostname on a domain name server is delegated to a separate server which performs its functionality in response to communication with the sender mail server .

One of ordinary skill in the art at the time the invention was made would have been motivated to make this modification since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlcincnan*, 168 USPQ 177, 179.

14. Regarding Claims 3 and 12, Delany discloses a **method and a system** (herein referenced as a **method**) **for delivering electronic messages from a sender to a recipient over a communications network, the method including:**

generating a unique identifier for the message from the sender to the recipient (Delany; column 5 lines 27-67 and column 6 lines 1-20, discloses generating a digital signature for the email message);

storing a hostname on a domain name server based upon this unique identifier for email transmission authorization (Delany; column 5 lines 27-67 and column 6 lines 1-20, discloses storing a text record including a hostname on a domain name server based on the digital signature for email transmission authorization);

Delany does not explicitly disclose receiving a delivery request from a sender mail server, the delivery request including a recipient email address and a sender identification.

However, Delany delegates the responsibility of generating a unique identifier for the email message and storing a hostname on a domain name server based on the unique identifier directly to the sender mail server. The sender mail server, as disclosed by Delany, performs the steps of generating a unique identifier and storing a hostname on a domain name server when transmitting the email. Hence, the step of receiving a delivery request from a sender mail server is integrated into the functionality of the prior art sender mail server, as disclosed by Delany.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify a sender mail server generating a unique identifier for the email message and storing a hostname on a domain name server based on the unique identifier, as disclosed by Delany, such that the functionality of generating a unique identifier and storing a hostname on a domain name server is delegated to a separate server which performs its functionality in response to communication with the sender mail server.

One of ordinary skill in the art at the time the invention was made would have been motivated to make this modification since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erliecnrnan*, 168 USPQ 177, 179.

Delany discloses verifying authorization of an email message, wherein verifying authorization of the email message includes the extraction of the unique identifier generated for the sender from the received mail server and querying a domain name server based upon this unique hostname (Delany; column 6 lines 20-67 and column 7 lines 1-2,

discloses verifying authorization of an email message by using the digital signature included the email message transmission to query a domain name server);

Delany does not explicitly disclose receiving an email message verification request from a recipient mail server; and transmitting a verification result to the recipient mail server.

However, Delany delegates the responsibility of verifying the authorization of the email message directly to the recipient mail server. The recipient mail server, as disclosed by Delany, performs the step of verification in response to receiving an email message instead of making a request to another server to verify the email message. Hence, the steps of receiving an email message verification request from a recipient mail server, and transmitting a verification result to the recipient mail server are integrated into the functionality of the prior art recipient mail server, as disclosed by Delany.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify a recipient mail server verifying the authorization of an email message, as disclosed by Delany, such that the functionality of verifying the authorization of an email message is delegated to a separate server and the recipient mail server determines the authorization of the email message through communication with the separate server.

One of ordinary skill in the art at the time the invention was made would have been motivated to make this modification since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlcnrnan*, 168 USPQ 177, 179.

15. Regarding Claims 4 and 13, Delany, as modified, discloses each and every limitation of Claims 3 and 12. Delany further discloses **wherein verifying authorization of the email message includes retrieving the hostname from the domain name server** (Delany; column 6 lines 20-67 and column 7 lines 1-2, discloses verifying authorization of the email message by retrieving a text record including a hostname from the domain name server).

16. Regarding Claims 5 and 14, Delany, as modified, discloses each and every limitation of Claim 3 and 12. Delany further discloses **wherein the verification result allows transmission of the email where first and second component values of the resolved hostname match with encoded values of the sender and recipient addresses respectively** (Delany; column 6 lines 20-67 and column 7 lines 1-2, discloses allowing the email transmission when the components of the header, as determined from the resolved digital signature, match the values of the sender and recipient addresses).

17. Regarding Claims 6 and 15, Delany, as modified, discloses each and every limitation of Claims 3 and 12. Delany further discloses **wherein the verification result allows transmission of the email where the value of only a first component of the resolved hostname matches an encoded value of the sender address** (Delany; column 6 lines 20-67 and column 7 lines 1-2, discloses allowing the email transmission when a component of the header, as determined from the resolved digital signature, matches the value of the sender address).

18. Regarding Claims 7 and 16, Delany, as modified, discloses each and every limitation of Claims 3 and 12. Delany further discloses **wherein the verification result disallows transmission of the email where the hostname is not found in the domain name server, where first or second components of the resolved hostname do not match encoded values of the sender or recipient addresses respectively, or where the first component value of the resolved hostname does not match the encoded value of the sender address** (Delany; column 6 lines 20-67 and column 7 lines 1-2, discloses disallowing the email transmission when the text record including the hostname does not exist, or when components of the header, as determined from the resolved digital signature, do not match the values of the sender or recipient addresses).

19. Regarding Claims 11 and 20, Delany, as modified, discloses each and every limitation of Claims 3 and 12. Delany further discloses **wherein the delivery request includes an identification of a sender email address and a recipient email address** (Delany; column 5 lines 27-67 and column 6 lines 1-20, discloses generating a digital signature for the email message using the sender and recipient email address.)

20. Claims 8-10, and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Delany as applied to Claims 3 and 12 above, and further in view of U.S. Patent No. 7,219,131 to Banister et al. (hereinafter 'Banister').

21. Regarding Claims 8 and 17, Delany, as modified, discloses each and every limitation of Claims 3 and 12. Delany does not explicitly disclose, but Banister discloses **adding the sender**

to a list of allowed senders (Banister; column 1 lines 60-67 and column 2 lines 1-6, discloses the use of white-lists in filtering emails).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify authorizing emails, as disclosed by Delany, to include adding a sender to a white list, as disclosed by Banister.

One of ordinary skill in the art at the time the invention was made would have been motivated to make this modification in order to filter emails more accurately and effectively.

22. Regarding Claims 9 and 18, Delany, as modified, discloses each and every limitation of Claims 3 and 12. Delany further discloses **providing the recipient control options for future correspondence received from the vendor** (Banister; column 1 lines 60-67 and column 2 lines 1-6, discloses providing the recipient the ability to place the sender in white-lists or black-lists).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify authorizing emails, as disclosed by Delany, to include providing the recipient the ability to place the sender in white-lists or black-lists and thereby control future correspondence received from a sender, as disclosed by Banister.

One of ordinary skill in the art at the time the invention was made would have been motivated to make this modification in order to filter emails more accurately and effectively.

23. Regarding Claims 10 and 19, Delany, as modified, discloses each and every limitation of Claims 3 and 12. Delany does not explicitly disclose, but Banister discloses **generating a database query to determine whether the recipient has opted out of receiving**

communications from the sender (Banister; column 1 lines 60-67 and column 2 lines 1-6, discloses the use of black-lists in filtering emails).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify authorizing emails, as disclosed by Delany, to include using a black list to determine whether a recipient has prohibited messages from a sender, as disclosed by Banister.

One of ordinary skill in the art at the time the invention was made would have been motivated to make this modification in order to filter emails more accurately and effectively.

Conclusion

24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sender Policy Framework Project – Describes the sender policy framework for sender authentication.

Fecyk. Designated Mailers Protocol. – Describes the designated mailers protocol for sender authentication.

Danisch. A DNS RR for Simple SMTP Sender Authentication. – Describes RMX for sender authentication.

Lyon. Sender ID: Authenticating E-Mail. – Describes the Sender ID Framework for sender authentication.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VIVEK KRISHNAN whose telephone number is (571)270-5009.

The examiner can normally be reached on Monday through Friday from 7:30 AM to 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Taghi Arani can be reached on (571) 272-3787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

VK

/Taghi T. Arani/
Supervisory Patent Examiner, Art Unit 4121
2/4/2008